

### **REMARKS**

In the Office Action, the Examiner rejected claims 1-13, 15-18, 20-25, 27, and 28 and objected to claims 14, 19 and 26. By the present Response, claims 1-27 are amended and claim 28 is canceled. Claim 29 is added by the present Response. Support for claim 29 may be found at page 7, lines 5-10 and at page 9, line 27 to page 20, line 22 as well as throughout the application. Upon entry of the amendments, claims 1-27 and 29 will be pending in the present patent application. Reconsideration and allowance of all pending claims are requested.

### **Claim Objections**

The Examiner objected to claims 1, 13, and 14 for failing to recite a controlling means. The Applicants can discern no statutory basis for these objections nor does the Examiner allege such a basis. Nevertheless, in order to advance prosecution, the Applicants have amended independent claim 1 to recite a system controller. Because claims 13 and 14 depend from claim 1, the present amendment is believed to address all present objections. Furthermore, as there appears to be no statutory or caselaw basis for the present objections, the present amendments are not believed to be made for reasons related to patentability, but instead merely represent a good faith attempt to advance prosecution of the present application.

### **Rejections Under 35 U.S.C. § 102**

The Examiner rejected claims 1, 2, 9-12, 17 and 21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,057,725 (the "Wagner reference"). In addition, the Examiner rejected claims 1, 3-8, 16, 17 and 22 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,674,837 (the "Taskar reference"). Applicants respectfully traverse these rejections.

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q.

773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (Emphasis added). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

#### *The Wagner Reference*

In the present case, the Wagner reference does not anticipate Applicants' claims under 35 U.S.C. § 102(b) because every element of the claimed invention is not identically shown in the Wagner reference. In particular, independent claim 1 recites that the respective streams of radiation are emitted through a respective *portion* of a field of view. (Emphasis added). As will be appreciated by the Examiner, the term “portion,” both in its common usage and in view of the specification, connotes that the respective streams of radiation are emitted through something less than the entire field of view. See Merriam Webster's Collegiate Dictionary, p. 967 (11th Edition, 2005) (defining a “portion” as “an often limited part of a whole”) and the Application, Figs. 2-7, 9 and page 10, lines 8-11, 19-22, page 11, lines 5-11, 18-28, and throughout.

The Wagner reference, conversely, appears to disclose respective streams of radiation which encompass the field of view of the respective imaging system. See Wagner, Figs. 1 and 2. Indeed, the Applicants can find no indication in the Wagner reference that less than the entire in-plane field of view of the disclosed system is encompassed by the respective wedge-shaped beams 7 of emitted radiation. Furthermore,

the passage relied upon by the Examiner as disclosing this recited matter does not disclose that the emitted wedge-shaped beams 7 of radiation traverse less than the field of view of the disclosed system. Absent some showing by the Examiner that this recited subject matter is present in the Wagner reference, no *prima facie* case of anticipation based on the Wagner reference exists for independent claims 1 and 17 or their dependent claims. Withdrawal of the rejection under 35 U.S.C. § 102 in view of Wagner is, therefore, respectfully requested.

#### *The Taskar Reference*

With regard to the Taskar reference, the Applicants respectfully note that independent claims 1 and 17, as amended, recite that the emitted streams of radiation are *conical or fan-shaped*. After review of the Taskar reference, the Applicants believe that the emission of conical or fan-shaped streams of radiation are not disclosed by this reference. To the contrary, the Taskar reference states that, “[i]n operation circuit 74 will operate to cause a scanned *narrow* X-ray 84 beam to emanate from X-ray source 20.” Taskar, col. 5, lines 37-39. (Emphasis added). Furthermore, in discussing key aspects of the invention, the Taskar reference emphasizes the significance of using “‘narrow’ emitters” and that the desired results could not be obtained by a system employing an expanding beam. Taskar, col. 5, line 52 and col. 6, lines 8-10.

In view of these representations in the Taskar reference and absent some showing by the Examiner that this recited subject matter is indeed present in the Taskar reference, no *prima facie* case of anticipation based on the Taskar reference exists for independent claims 1 or 17, or for their dependent claims. Withdrawal of the rejection under 35 U.S.C. § 102 in view of Taskar is, therefore, respectfully requested.

#### **Rejections Under 35 U.S.C. § 103**

The Examiner rejected claims 23-25 under 35 U.S.C. § 103(a) as being obvious in view of the Taskar reference. In addition, the Examiner rejected claims

15, 20 and 27 under 35 U.S.C. § 103(a) as being obvious in view of the Taskar reference and U.S. Patent No. 5,764,721 (the "Light reference"). The Applicants respectfully traverse these rejections.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

With regard to the rejection of independent claim 23 in view of Taskar, the Applicants have amended independent claim 23 to recite the emission of conical or fan-shaped streams of radiation, as discussed above. Therefore, claim 23, as amended, and those claims depending therefrom, are believed to recite subject matter neither disclosed nor suggested by the Taskar reference and no *prima facie* case of

obviousness is believed to exist. Reconsideration and allowance of independent claim 23 and those claims depending therefrom is, therefore, respectfully requested.

With regard to the rejection of dependent claims 15, 20 and 27 in view of Taskar and Light, the Applicants respectfully note that the respective amended independent claims from which these claims depend recite subject matter, as discussed above, which is not believed to be present in either reference. Furthermore, the Applicants respectfully disagree with the Examiner's assertion that one skilled in the art would be motivated to combine the Taskar and Light references in the manner suggested by the Examiner. In particular, the Examiner has produced no objective teaching or suggestion in either reference supporting the combination, as required under the case law cited above. Indeed, the Taskar reference is directed generally to reducing scatter using a pixilated source in sync with the detector (Taskar, Abstract and col. 1, lines 26-52) while the Light reference is directed generally to adjusting a beam intensity using design data for object with large length-to-width ratios (Light, Abstract and col. 4, lines 32-26). In view of the disparate issues being addressed by these references, no objective suggestion or motivation to combine the disclosed techniques is evident in the references themselves, nor does the Examiner provide a citation to such a suggestion or motivation. Instead, by selectively picking out one aspect of the Light reference and by combining that aspect with the unrelated Taskar reference for the sole and unsupported purpose of denigrating the present claims, the Examiner appears to have impermissibly engaged in hindsight analysis where the desired result drives the analysis, not the teachings of the references. Therefore, claims 15, 20, and 27 are believed allowable not only for their reliance on the subject matter of their respective independent claims but also in view of the improper combination of references employed in formulating the rejection. Reconsideration and allowance of claims 15, 20, and 27 is, therefore, respectfully requested.

**New Claims**

Independent claim 29 has been added by the present amendment. As noted above, support for this claim can be found at page 7, lines 5-10 and at page 9, line 27 to page 20, line 22 as well as throughout the application. Independent claim 29 includes limitations such as those described above and is presently believed to be in condition for allowance for at least those reasons noted above with regard to claim 1. Allowance of claim 29 is, therefore, respectfully requested.

**Conclusion**

The Applicants wish to thank the Examiner for briefly discussing the present application and Office Action on August 29, 2005. In view of the Examiner's comments, the Applicants have made minor amendments in a number of the claims to clarify the scope and contemplated subject matter of the respective claims. These amendments are not made for reasons related to patentability, but instead are merely intended to clarify the subject matter of the claims based on the Examiner's questions and comments. If the Examiner has any questions related to the present amendments, she is encouraged to contact the undersigned at the number below at her earliest convenience.

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

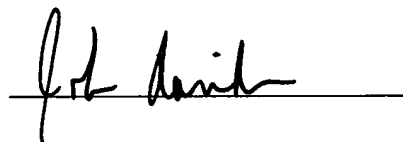
**General Authorization for Extensions of Time**

In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request therefor. Furthermore, Applicants authorize the Commissioner to

charge the appropriate fee for any extension of time to Deposit Account No. 07-0868;  
Order No. 129405-1/YOD/RAR (GERD:0049).

Respectfully submitted,

Date: August 31, 2005

A handwritten signature in black ink, appearing to read "John M. Rariden", is written over a horizontal line.

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